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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/620,211 03/29/96 PURVIS

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JOHN G MILLS & ASSOCIATES  
823 BUSINESS PARK  
PO BOX 587  
WAKE FOREST NC 27588-0587

CSM1/0203

EXAMINER

CHOP, A

ART UNIT

PAPER NUMBER

3509

DATE MAILED:

03/03/97

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/620,211**

Applicant(s)  
**Purvis et al.**

Examiner  
**Andrea Chop**

Group Art Unit  
**3509**



- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- ☒ Claim(s) 1-14 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-14 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☒ The drawing(s) filed on Mar 29, 1996 is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☒ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948 ✓
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **Part III DETAILED ACTION**

#### *Oath/Declaration*

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It states that the two inventors are sole inventors, not joint inventors of the invention claimed.

#### *Drawings*

2. The drawings are objected to because they do not include certain reference signs mentioned in the description. 37 CFR § 1.84(f) states, "Reference signs not mentioned in the description shall not appear in the drawing and vice versa." The following reference signs are not included in the drawings: "16'" as discussed on Page 18 line 1; "20'" on top of pole 40' as discussed on Page 18 first paragraph. Correction is required.

*Specification - Objections*

3. The title should be changed so as to be clearly indicative of the invention to which the claims are directed, i.e., "and Method of Using the Same" should be deleted.

4. The disclosure is objected to because of the following informalities:

Page 3, line 14, change "Number 20,653" to

--Number RE 20,653--.

Appropriate correction is required.

5. The Abstract of the Disclosure is objected to because "This invention is an" should be changed to --An--. Correction is required. See M.P.E.P. § 608.01(b).

*Claim Rejections - 35 USC § 112*

6. Claims 1-14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As concerns Claim 1, "the bottom end" lacks antecedent basis, both for referring to "bottom" without a frame of reference and for referring to "the end" when no ends of the stanchion have been defined. Also, this claim as presented is indefinite in that it is not clear as to whether the temporary

guard rail system is being claimed *in combination* with the building structure; Claim 1 states "and being adapted to be removably mounted to a building structure" which implies that the intention is not to claim the building structure. However, further on, Claim 1 recites "said toe board being positioned adjacent the floor of said building structure", thus claiming the building structure. Clarification of the intention of this claim is necessary.

As concerns Claim 2, "an upper horizontal side rail" should be changed to --an upper side rail-- to avoid improper antecedence.

As concerns Claim 3, the use of "may be" and "by use of" is indefinite in that it is unclear whether the "adapter means" is being claimed or not. Also, the term(s) adapter is used to modify the word "means", thus purporting to conform to 35 USC 112, sixth paragraph. However, 35 USC 112, sixth paragraph, requires that the term(s) specify a function to be performed, thus enabling a determination of the structural equivalent thereof. For example, expressions such as "latch means" or "means for latching" have functional connotations and are in conformity with the statute. However, in this case, the term(s) have no functional connotations. See *Ex parte Klumb*, 159 USPQ 694. Correction is required.

As concerns Claim 4, "adapter means" and "swivel plate means" do not conform to 35 USC 112, sixth paragraph. Also,

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"said first threaded stud", "said top end", "said top stanchion" and "said swivel plate" (line 7) lack antecedent basis.

As concerns Claim 5, "swivel plate means" does not conform to 35 USC 112, sixth paragraph.

As concerns Claim 6, "adapter means" (two occurrences) does not conform to 35 USC 112, sixth paragraph.

As concerns Claim 7, "adapter means" does not conform to 35 USC 112, sixth paragraph.

As concerns Claim 11, "ground adapter plate means" does not conform to 35 USC 112, sixth paragraph.

As concerns Claim 12, "ground (adapter) plate means" (two occurrences) does not conform to 35 USC 112, sixth paragraph.

As concerns Claim 13, "roof adapter plate means" does not conform to 35 USC 112, sixth paragraph.

As concerns Claim 14, "roof adapter plate means" does not conform to 35 USC 112, sixth paragraph.

### *Double Patenting*

7. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-3, 6, 9 and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-8, 10-13 and 17 of copending Application No. 08/755,596 in view of Lamb 2,136,696 and Bourn et al.

Application No. 08/755,596 discloses the claimed invention, but lacks a toeboard and a means for extending the vertical height of the guard rail system. Lamb teaches the use of a telescopically adjustable toeboard. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the guard rail system to have a telescopically adjustable toe board in view of Lamb '696 in order provide a means to protect objects from rolling off a staircase

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or balcony where the guard rail system is installed and to allow adjustability of the toeboard in the same manner as the side rails, i.e., telescoping capability. Bourn et al. teaches the use of a means for extending the vertical height of a guardrail system. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the guard rail system to have a means for extending the vertical height thereof in view of Bourn et al. in order to provide a more versatile guard rail system which can be adjusted vertically based on the site circumstances, height of workers, etc.

9. Claims 11-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-8, 10-13 and 17 of copending Application No. 08/755,596 in view of Lamb 2,136,696, Bourn et al. and Stewart, Jr.

Application No. 08/755,596, Lamb '696 and Bourn et al. show the claimed invention, but lack a ground adapter plate means. Stewart, Jr. shows a ground adapter plate means (that portion of plate 12 which connects with 13; the other portion of 12 being considered as the anchor bracket). It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the guard rail system to have a ground adapter plate means in view of Stewart, Jr. in order to provide a more stable connection to the ground surface.

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This is a provisional obviousness-type double patenting rejection.

10. Claims 1-3, 6, 9-14 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 08/755,596 which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future patenting of the conflicting application. Application No. 08/755,596 shows the claimed invention except for the telescoping toeboard, the vertical height adjustment and the adapter plate means. These items have been shown to be known in the art as discussed above.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131.

### *Allowable Subject Matter*

11. Claim 1 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112.

12. Claims 2-14 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

### *Conclusion*

13. Since allowable subject matter has been indicated, Applicant is encouraged to submit formal drawings in response to this Office Action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Arteau et al. shows an anchor bracket. Ouelette et al., Weinert, Brueske, France 1,383,061, France 2,384,918, and France 2,596,441 show an adapter plate means. Kostelecky shows a toeboard with height adjustment screws on the stanchions. Newman shows a height adjustment arrangement in which the extension is attached over the outside diameter of an existing stanchion.

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Boyanton et al., Leyendecker, Bailey, Russell and Reinklou show pivotal connections of side rails. Bloch shows a height adjustment with a stud on the top end. Juculano shows a toeboard and vertically pivotable side rails. Lionetto shows a vertical height adjustment, a toeboard and vertically pivotable side rails. Sabel et al., Ashworth et al. and Japan 406322920 show L-adapters.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea Chop whose telephone number is (703) 305-6358. The fax numbers for the Group are (703) 305-3597/8.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.

AC  
AMC

February 26, 1997

  
KENNETH J. DORNER  
SUPERVISORY PATENT EXAMINER  
GROUP 3500